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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,703	05/14/2001	John Muraca	1503.1002	6536
21171	7590	10/14/2009		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER NGUYEN, TRAN N	
			ART UNIT 3626	PAPER NUMBER
			MAIL DATE 10/14/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/853,703	Applicant(s) MURACA, JOHN	
	Examiner Tran Nguyen	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-21,23-35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-21,23-35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/11/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

As per the Office Action mailed 12/18/2008:

The objection to claims 2, 9-14 under 37 CFR 1.75(c) is hereby withdrawn in view of Applicant's amendment to claim 2.

The rejection of claims 2, 6-7, 9-14 under 35 USC 112, second paragraph is hereby withdrawn in view of Applicant's amendment to claims 2, 6-7.

The rejection of claims 15-21, 23-28 under 35 USC 101 is hereby withdrawn in view of Applicant's amendment to claim 15.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 09/11/2009 is entered and considered by Examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1-5, 7, 9-19, 21, 23-33, 35, 37-42 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (5664109) in view of Applicant Admitted Prior Art (AAPA).

It is noted that the official notice taken in the previous Office Action is taken to be AAPA because Applicant failed to adequately traverse Examiner's assertion.

As per claim 1, Johnson teaches a system (reads on "an apparatus") (Figure 1), comprising a computer system (Figure label 112) capable of:

(a) executing software to share patient records (reads on "portability enabling software") (column 2 line 13-26);

(b) storing a master patient record (reads on "master control file") (Figure 7 label 702);

(c) sharing (reads on "controlling and providing interoperability") medical records between a plurality of providers, wherein each provider need not adopt standard patient identifiers, medical formats, hardware, or software (reads on "computer platforms operating on disparate operating systems") (column 2 line 27-37);

(d) using software to interface with a database containing therein text data, image data, patient records (Figure 7), and the plurality of providers (Figure 2).

Insofar as “the computer platforms including a personal computer, a hand-held device, and a network”, Johnson need not teach these structural limitations because these limitations are not part of the claimed apparatus.

To the extent that these limitations are claimed, Examiner submits that the applied art need only teach that the known system is capable of communicating with a PC, a hand-held device, and a network.

The system of Johnson is capable of interfacing with any device that conforms to router network protocol (Figure 1 label 118). Therefore, Examiner submits that the disclosed system fully meets this limitation because any computer conforming to the prescribed router network protocol is capable of communicating with the system of Johnson.

Assuming that Applicant successfully amends the claim to encompass these limitations, Johnson teaches that the system is capable of:

(e) communicating with a plurality of subscriber computer systems (reads on “a personal computer”) over a network (Figure 1 label 118).

Johnson does not teach “hand-held device”.

AAPA teaches that laptop computers and palmtop computers are old and well established in the art of network computing.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of

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Johnson with the motivation of providing physicians with wireless computing platforms for convenience.

Johnson further teaches:

(f) the master patient record is capable of being used to serve a plurality of queries from the plurality of subscribers (reads on “interfaces with the disparate operating systems”) (Figure 8 label 804-805);

(g) the master patient record is capable of mapping documents containing therein text and image data stored in a database to patient records (Figure 7);

(h) the system is capable of maintaining the database (Figure 7);

(i) receiving and storing the documents (Figure 4-6);

(j) storing (reads on “capture”, “populate”, “maintain”) and retrieving the stored documents, wherein the documents are stored in their native formats (reads on “a plurality of image and text formats”) (Abstract and throughout);

(k) the master patient record is capable of linking with a plurality of documents in any format (Figure 7, Abstract), and the plurality of subscribers (Figure 1);

(l) providing patient data (reads on “patient episode data”) electronically over network (Figure 2).

Johnson further teaches that computer security is well known and should be applied to medical information (column 14 line 4-25).

Johnson further teaches that e-mail is also known in the art and may be used to communicate medical data (column 5 line 23-25).

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Johnson further teaches receiving the transmitted patient data for storage (Figure 2 label 208).

Johnson does not teach “a secure file, transmitting the secure file as an e-mail attachment, retrieving the patient episode data from the secure file”.

AAPA teaches that sending a file via encrypted email is old and well established in the art of network security.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of Johnson and AAPA with the motivation of providing an efficient form of file transfer that is easy for physicians to use.

The skilled artisan would have recognized the benefit that since physicians are already familiar with emailing, it would be easier to use email to submit patient data than to train physicians to use a different interface.

As per claim 2, Examiner submits that any hand-held device within the scope of claim 1 and capable of communicating with the apparatus inherently executes “medical software” to communicate with the claimed apparatus.

Therefore, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

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As per claim 3, Johnson teaches that the system is capable of accepting documents from the plurality of subscribers (reads on “interoperability to populate, maintain”) (Figure 1) and retrieving information for the plurality of subscribers (Figure 8).

As per claim 4, Johnson teaches that the system is capable of maintaining the database (reads on “controls path and name of folder images, path to and name of the database, database field names, attributes, and locations on the folder image”) (Figure 7, Figure 3).

Examiner considers a database table containing therein the documents to be a “folder”.

As per claim 5, Johnson teaches storing the document with the original headings (reads on “each field name”) (Figure 5 label ADMITTED WITH, MEDICAL SUMMARY, etc.).

As per claim 7, Johnson teaches linking the document identifier to the master patient identifier for display (reads on “name”) (Figure 7 label 706).

Examiner also considers the foreign key linking to be a form of “pointer”.

As per claim 9, Johnson teaches that the system is capable of storing medical data (Figure 7).

As per claim 10, Johnson teaches that the system is capable of allowing remote subscribers to review patient records (Figure 8).

As per claim 11, Johnson teaches that the system is capable of allowing remote subscribers to review patient records (reads on "health indicators") (Figure 8).

As per claim 12, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

Examiner considers encryption to be a form of "compresses".

As per claim 13, this claim is rejected for substantially the same rationale as applied to claim 1 above, and incorporated herein.

As per claim 14, Johnson teaches database triggers capable of notifying subscribers that new patient data is available for a specific patient of interest (Figure 4 label 422).

As per the set of claim(s): 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 35, 37, 38, 39, 40, 41, 42, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, 2, 3, 4, 5, 7, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 21, 23, 24, 25, 26, 27, 28, respectively, and incorporated herein.

Claim(s) 6, 20, 34 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and AAPA as applied to parent claims 4, 19, 32 above, and further in view of Amit (Federated Database Systems for Managing Distributed, Heterogeneous, and Autonomous Databases, MAILED 12/18/2008).

As per claim 6, Johnson does not teach “the pointer to and the name of the database indicates the database”.

Amit teaches a federated database system, wherein schemas are mapped (reads on “the pointer to and the name”) between databases (page 192 Section 1.1).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Amit within the embodiment of Johnson and AAPA with the motivation of providing increased availability, increased reliability, and improved access time (Amit; page 185 column 2 Section Distribution).

As per the set of claim(s): 20, 34, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, 20, respectively, and incorporated herein.

Response to Arguments

Applicant's arguments filed 06/18/2009 have been fully considered but they are not persuasive.

On page 10 Applicant argues:

(a) The Examiner relies upon Johnson, col. 2, at lines 13 - 26, as discussing "portability enabling software". However, Johnson, col. 2, at lines 13 - 26, discusses a "centralized record keeping system", rather than "portability enabling software" as in the present invention.

(b) The Examiner relies upon Johnson, Figure 7, label 702 ("master patient records"), as teaching "master control file" of the present invention. However, master patient records of Johnson does not correspond to the "master control file" of the present invention. Johnson, col. 13, lines 13 - 15 discusses "Records in tables 702 and 704...comprise the MPI database, as indicated by dashed line 703". That is, Johnson, col. 13, lines 13-15, teaches away from the present invention rather than discussing a "master control file" as in the present invention.

First, Applicant provides no definition for "master control file". Instead, Applicant repeatedly argued that the applied art does not teach this limitation without providing a controlling definition.

Examiner is forced to interpret this limitation broadly. In particular, this "file" may be any piece of data contained in software. Therefore, this amounts to mere functional claiming because any structure contained in the computer capable of performing the functionality may be interpreted to be enveloped by this limitation.

Applicant is requested to provide a clear controlling definition with adequate support from the specification as originally filed or the level of ordinary skill in the art.

Continuously refuting Examiner's best effort to interpret claims drafted by Applicant to capture an invention supposedly invented by Applicant without providing a

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controlling definition of the claim features would unnecessarily prolong prosecution and would prevent early and favorable consideration of the pending claims.

Second, in order to have an adequate teaching away in the art, the art must first teach the claimed combination. Then the art must criticize, discredit, or otherwise discourage the solution claimed. *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

In this case, Johnson fully teaches this limitation based on the broad interpretation Examiner was forced to adopt because Applicant provides no controlling definition. Additionally, nowhere does Johnson criticize, discredit, or otherwise discourage the claimed solution. Instead, Johnson teaches that the system must interact with a plurality of different systems and different standards to provide interoperability between different systems so that a unified standard need not be adopted (Figure 2 and throughout).

On page 11 Applicant argues:

Johnson does not discuss or suggest "a master control file controlling and providing interoperability of a medical records system between computer platforms operating on disparate operating systems, the master control file interfacing with a database of text and image data and medical records and with the disparate operating systems, and the computer platforms including a personal computer, a hand-held device, and a network" as recited in independent claims 1, 15, and 29 of the present application.

Applicant provides no definition for "personal computer".

Examiner broadly interprets this limitation to recite any computer.

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According to Johnson, the physician uses their own computer to upload the files (Figure 1-2).

Therefore, the applied art fully teaches using a computer to connect over a network.

On page 12 Applicant argues:

More specifically, the Examiner has not provided any reasoning to support the Examiner's assertions that "laptop computers and palmtop computers are old and well established in the art of network computing", particularly taking into account the filing date and priority dates of the subject application.

Applicant argues that on 07/28/2000, laptop computers and wireless palmtop computers were not known in the art of medical data processing.

Schanz (6064968) teaches that laptop and palmtop computers were well known before Applicant's priority date (column 9 line 27-28). Schanz further teaches that it is well known to use these devices for legal purposes when practicing medicine (Abstract and throughout).

Therefore, Applicant's traversal is inadequate.

On page 12 Applicant further argues:

It is respectfully submitted that the Examiner is improperly relying upon hindsight in these assertions. Moreover, the Examiner's assertions of Official Notice are respectfully traversed, as discussed above.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that

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any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this case, all knowledge was derived from the applied art. No portion of Applicant's disclosure was relied on for the rejection.

On page 13 Applicant argues:

Moreover, Johnson does not identify or address providing wireless platforms for the convenience of physicians.

Thus, the claimed invention as a whole would not have been obvious to one of ordinary skill in the art at the time the invention was made.

This argument has been fully addressed above, and incorporated herein.

On page 13 Applicant argues:

As the Examiner admits that Johnson does not a "hand-held device", Applicant respectfully submits that the Office Action does not articulate a reason for combining the references cited to support the legal conclusion of obviousness and to reject the claims.

The rationale has been fully articulated in the previous Office Action, and reproduced above for Applicant's convenience.

On page 13-15, Applicant makes various assertions that the applied art do not teach the claimed features.

In making these arguments, nowhere does Applicant present any controlling definitions for these features.

While Applicant is not required to furnish a controlling definition, failing to do so forces Examiner to adopt a broad interpretation of these limitations.

Therefore, Applicant is requested to provide a controlling definition so that the claim may be compared/contrasted with the applied art.

As currently applied, Examiner submits that these claim features are very broad, and are fully encompassed by the applied art absent any further showing by Applicant.

On page 15 Applicant argues:

The Examiner takes Official Notice that sending a file encrypted by e-mail is old and well established in the art of network security.

The Examiner's assertions of Official Notice are respectfully traversed. The Examiner's assertions of Official Notice are not properly officially noticed and not properly based upon common knowledge. The Examiner is respectfully requested to support the assertion of Official Notice by citing a reference or by affidavit or withdraw same.

More specifically, the Examiner has not provided any reasoning to support the Examiner's assertions, particularly taking into account the filing date and priority dates of the subject application.

Epstein (6023510) teaches encrypting electronic messages (Figure 1).

On page 15-16 Applicant further argues that email was not known to physician.

Applicant's attention is directed towards class 705, subclass 2 containing therein thousands of references directed towards electronic messaging for physicians.

On page 16-18 Applicant asserts that the applied art do not teach the claimed invention without further explanation regarding the claim scope. It appears that Applicant is merely contradicting Examiner's assertion without any additional evidence.

Additionally, it appears that regardless of the amount of evidence presented by Examiner, Applicant is not satisfied with the teachings in the applied art.

Therefore, Applicant is requested to provide a discussion of the claim scope as contrasted with the applied art.

Absent this discussion, the claim scope as interpreted by Examiner is much broader than contemplated by Applicant. Therefore, the teachings of the applied art, although different from the specification, fully meet the broader claim scope.

On page 18 Applicant requests clarification why encryption is a form of "compress".

Applicant provides no definition for "compress".

Examiner relies on Merriam-Webster Online Dictionary, which defines "compress" as "reduce in size, quantity, or volume".

Encryption transforms data so that the meaning of the encrypted data is not easily gleaned. Therefore, the size, quantity, and volume of the meaning of the data is reduced.

Similar arguments are made on page 18-20, and are addressed above, and incorporated herein.

Conclusion

The central arguments presented by Applicant revolve around the dispute that wireless laptop/palmtop computers capable of interacting with a plurality of computers located at different remote locations via encrypted email is not well known in the art.

Applicant is suggested to present this issue on appeal so that guidance may be obtained.

In particular, if favorable ruling is made that in 2000, wireless laptop/palmtop computer, communicating with computers over a network, and encrypted email are not well known, early and favorable consideration of the application will be provided.

Applicant is requested to no longer prolong prosecution of this instant pending application with a priority date back to 2000, and to present the case for appeal so that the pendency of this application may be reduced.

The new ground(s) of rejection presented in this Office action, if any, was/were necessitated by Applicant's amendment. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3626

10/13/2009

/Robert Morgan/

Primary Examiner, Art Unit 3626